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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/243,016	02/02/1999	DIRK LENZ	BEIERSDORF54	1839

7590 02/11/2002

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EXAMINER

GHALI, ISIS A D

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 02/11/2002

*LL*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/243,016

Applicant(s)

Lenz et al.

Examiner

Isis Ghali

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1615



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 17, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

The receipt is acknowledged of applicants' request for extension of time and amendment C, both filed 1/17/2002.

Claim 2 has been canceled.

**Claims 1, 3-13 are pending in the application and the status of the claims as follows:**

1. Claims 1, 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '649, US '645, US '603, or US ('013) each by itself or in combination.

The rejection has been discussed in the previous office action and maintained for reasons of record.

### ***Response to Arguments***

2. Applicant's arguments filed 1/17/2002 have been fully considered but they are not persuasive.

The main gist of applicant argument against the rejection of claims 1, 3-13 under 35 U.S.C. 103(a) as being unpatentable over WO '649, US '645, US '603, or US ('013) each by itself or in combination is that:

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- ◆ The cited references are all based on a single layer of foam.
- ◆ There is nothing in any of the references, separate or in combination, that suggest two layers of foam, top layer and inner layer, wherein the inner layer is coated with adhesive.

In response to the above argument, the examiner position is that: although the multiple layers of foam are well known in the art, as well as, the adhesive on the inner layer facing the body surface, the examiner is pointing out to:

- ◆ One or more polyurethane thin foam layers are in the teachings of US '013, col.11, lines 5-12.
- ◆ The adhesive coating on the skin facing layer is in the teachings of WO '649, page 5, lines 12-15, wherein one or more adhesive layers cover the foam layer; and in US '603, col.11, lines 16-18, wherein an adhesive layer contacts the wound and the surrounding skin. Further, US '013 teaches the effect desired by applicants of adhesion of the patch to the skin.

Conclusively, the references in combination or separately teach the claimed invention of patch comprising two layers of foamed material wherein the inner side being provided with an adhesive. A conclusion of obviousness under 35 U.S.C. 103(a) does not require absolute predictability, only a reasonable expectation of success; and

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references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ. 545 (CCPA 1969).

Accordingly, it would have been obvious for one having ordinary skill in the art at the time of the invention to produce an occlusive patch consisting of at least two layers of foam material with adhesive on its lower layer with reasonable expectation of success of the delivered patch as an ophthalmic light occlusive patch. Motivation would arise from the teaching of US '013 that the polyurethane foams are able to adhere to one another and many thin layers can be applied and result in the same effect as with thick foam layers.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

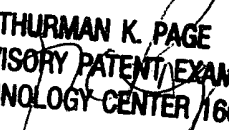
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Isis Ghali whose telephone number is (703) 305-4048. The examiner can normally be reached on Monday-Friday from 7:00 to 5:30 Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Isis Ghali

Patent Examiner

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600